

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : 10/789,422
Filing Date : February 27, 2004
First Named Inventor : Boris Y. Shekunov et al.
Attorney Docket No. : FER-14668.001
Confirmation No. : 5255
Title : METHOD AND APPARATUS FOR PRODUCING
PARTICLES USING SUPERCRITICAL FLUID
Examiner : Joseph W. Drodge
Art Unit : 1723

DECLARATION UNDER 37 C.F.R. §1.132
(In response to Paper No./Mail Date 20071117)

Pratibhash Chattopadhyay declares that:

1. I am a co-inventor of the subject matter claimed in the above-identified patent application.
2. I am also a co-inventor of the subject matter disclosed and claimed in Chattopadhyay et al., U.S. Pat. 7,083,748 (hereinafter referred to as "the '748 Patent").
3. All of the co-inventors of the subject matter claimed in the above-identified patent application and all of the co-inventors of the subject matter disclosed and claimed in the '748 patent were under an obligation to assign the inventions to Ferro Corporation at the time the respective inventions were made.
4. The above-identified patent application and the '748 patent are commonly owned.
5. Robert W. Huff is a co-inventor of the subject matter claimed in the above-identified patent application, but was not an inventor of the subject matter disclosed in the '748 patent.
6. Robert W. Huff obtained knowledge of the subject matter disclosed in the '748 patent before it was disclosed to the public by virtue of working with the other co-

Application No. 10/789,422
Declaration of Pratibhash Chattopadhyay
Reply to Office action of November 20, 2007

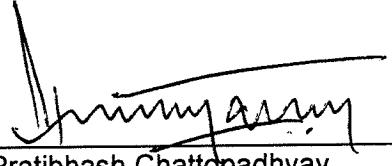
inventors at Ferro Corporation, and thus had knowledge of the subject matter disclosed in the '748 patent when the inventions claimed in the above-identified patent application were made.

7. The subject matter disclosed in the '748 patent is different than the subject matter claimed in the above-identified patent application.

8. The subject matter disclosed in the '748 patent relates to the production of a particle suspension by contacting an "emulsion" with a supercritical fluid in an extraction chamber. An "emulsion" comprises at least two liquid phases, namely a continuous phase and a discontinuous phase.

9. The subject matter claimed in the above-identified application relates to the production of a particle suspension by contacting a "solution" with a supercritical fluid, wherein the "solution" comprises a first solvent that is soluble in the supercritical fluid, a second solvent that is substantially insoluble in the supercritical fluid and is at least partially soluble in or miscible with the first solvent, and a solute that is soluble in the first solvent and is substantially insoluble in the second solvent and the supercritical fluid. The "solution" defined in the above-identified application is not an "emulsion" because the second solvent is at least partially soluble or miscible with the first solvent and thus the "solution" does not comprise at least two liquid phases.

10. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. §1001 and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

By: 
Pratibhash Chattopadhyay

Date: 1/3/2008